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**REMARKS**

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**PRESENT APPLICATION**

Claims 8 - 27 are now in this application. Claims 8 - 27 have been amended as indicated at Exhibit A hereto. Reconsideration of the Examiner's rejections is respectfully requested.

**RESPONSE TO OBJECTIONS**

The Examiner has objected to all of the claims. Applicant respectfully traverses such objections in part on the basis that the claims as drafter particularly point out and distinctly claim subject matter of the application.

The Examiner has objected to the claims as failing to be numbered not in accord with 37 CFR 1.126. Applicant has renumber claims 48 - 67 as claim numbers 8 - 27 as suggested by the Examiner. Applicant respectfully asserts that this objection is now overcome.

The Examiner also objects to claim 8, lines 1, 5, 8 and 16 due to several informalities. The Applicant has attempted to substantially conform with the Examiner's suggestions by amendment. It is therefore asserted that these objections are overcome.

The Examiner also objects to Claim 26, line 8. Again the Applicant has complied with the Examiner's suggestion, and it is believed that this objection is overcome as well.

## RESPONSE TO REJECTIONS

### 35 U.S.C. §102(e) Rejections

The Examiner has rejected claims 22 - 25 as being anticipated by U.S. Patent No. 5,970,469 to Scroogie *et al.* Applicant respectfully traverses such rejection.

In order for a reference to anticipate, every element must be found in the reference itself. Applicant respectfully asserts that each element of neither the unamended or amended rejected claims can not be said to be found in such reference. Applicant points out that there is no teaching or suggestion in the Scroogie *et al.* reference about maintaining or querying a relational database correlating a good with one or more associated characteristics of the good, or with respect to maintaining or querying a relational database correlating associated characteristics of goods with secondary purveyors of good or services directed to such associated characteristics. As such, Applicant respectfully asserts that the rejection for anticipation is clearly erroneous. Withdrawal of the rejection with respect to claims 22 – 25 is courteously solicited.

### 35 U.S.C. §102(b) Rejections

The Examiner has also rejected claims 26 - 27 under 35 U.S.C. §102(b) as being anticipated by Fahner *et al.* which the Examiner asserts “teaches a method for encoding concealed identifiers on an item, the method includes electromagnetic laser beams from laser 10 to a molten plastic material 14 on a part, the beams forming a unique identifier.” Applicant once more must respectfully traverse such rejection.

First, Applicant points out to the present Examiner that in Examiner Tremblay’s April 9, 1997 Office Action, Examiner Tremblay found claim 2, which claim 26 parallels, allowable noting that “the prior art of record fails to teach or suggest the encoding of concealed identifiers while the material is still in a molten or semi-molten state,” and

further notes that "while the difficulties in obtaining sufficient laser power are discussed in many of the disclosures, nothing in the prior art suggest treating an article in a molten or semi-molten state" (Lines 9 - 15, Page 6 of the April 9, 1997 Office Action). These statements were made after the Examiner had reviewed the Fahner *et al.* reference (U.S. Patent No. 4,822,973) (See IDS dated March 24, 1997). Applicant further notes that in his response filed with the continuation-in-part application, that Applicant brought the same to the attention of the present Examiner in reciting: "Allowable Subject Matter: The Examiner has indicated that Claim 8 is allowable. Former Claim 8 is now incorporated as New Claim 66. Applicant, therefore, respectfully asserts that New Claim 66 is allowable." Claim 66 has been renumbered 26, and is now not only found to be unpatentable by the present Examiner, but also to be anticipated by a reference specifically considered by the prior Examiner!

Applicant agrees with Examiner Tremblay that the Fahner *et al.* reference does not teach or suggest the invention claimed in independent claim 26, and therefore does not teach or suggest the subject matter of dependent claim 27 which depends from claim 26. The Examiner is simply incorrect in suggesting that Col. 4, lines 24 - 29 or Figure 3 and 4 of the Fahner *et al.* reference teach or suggest treating an article in a molten or semi-molten state. Applicant respectfully requests that such rejection be withdrawn, and the claim be reinstated as allowable.

#### 35 U.S.C. §103(a) Rejections

The Examiner further rejects Claims 8 - 21 under 35 U.S.C. §103(a). The Examiner asserts that Claims 8 - 11 and 21 are obvious in light of U.S. Patent No. 5,434,394 to Roach *et al.* in view of U.S. Patent No. 5,646,365 to Collier. Claims 12 and 15 - 20 are said to be obvious over U.S. Patent No. 5,434,394 to Roach *et al.*, as modified by U.S. Patent No. 5,646,365 to Collier, and further in view of U.S. Patent No. 5,768,384 to Berson. Claims 13 and 14 are said to be obvious in light of U.S. Patent No. 5,434,394 to Roach *et al.*, as modified by U.S. Patent No. 5,646,365 to Collier, and further in view of U.S. Patent No. 5,623,552 to Lane. Applicant respectfully traverses all of these rejections

in part based on a lack of motivation provided by the Examiner in combining the references in the manner suggested, and also based on a teaching away of Collier from the present invention.

First, Applicant points out to the new Examiner that the Collier reference (U.S. Patent No. 5,646,365) was first considered by Examiner Tremblay prior to March 24, 1997 (See IDS of such date). Examiner Tremblay used the reference once to reject under anticipation, and then once under obviousness in combination with another reference (to reject claim 3), over 5 years ago (See, April 9, 1997 Office Action). He did not see fit to raise the reference again. It does not appear to Applicant that Examiner Tremblay in the end felt that the reference was overly compelling given his remark in the November 21, 1997 Office Action to the extent that "the need for Collier was slight in the previous office action."

While Examiner Tremblay appears to have spent considerable effort seeking a reference teaching the need to correlate the identification data with the good's manufacture or source of origin (See page 5, lines 2 -3 of the April 9, 1997 Office Action), respectfully, the present Examiner finds such correlation in the Collier "good identifier" itself, the present Examiner characterizing the identifier as "reflect[ing] the type of bullet, the lot and the manufacture of the bullet" (See, page 5, lines 5 - 6 of the present Office Action). No support, however, is provided for such statement, and Applicant is amiss as to where even an implication of the same is found in Collier. In fact, the Examiner's statement that Collier teaches the information pertaining to the customer who purchased the bullets would be held "within a national computer database", and Collier's teaching that the "number or code on the identification tag is then read and input into the computer to retrieve the name or identity of the purchaser of the bullets" suggest no need for the identifier identifying the manufacturer of the particular good. Such becomes necessary when one attempts to correlate numerous products with purchasers of products, and one considers the impracticability of having all manufacturers obtain serialized allotments of unique identifiers from some central database and then

storing all information pertaining to purchasers of products in a central database. Applicant further asserts that the latter statements in Collier also contradict the Examiner's assertion that there is a "bar code in the bullet" of Collier (See page 5, line 9 of the present Office Action) something not evident in any of the material said to support such statement. Applicant notes that Collier had no problem talking of a "machine readable" code on the exterior of the package, but references only an "identification number or code" being imprinted on the identification tag placed within the material comprising the bullet. Note that the tag of Collier is melted away from a slug. Does such suggest in any manner that a bar code, conventionally having a low deformation tolerance for appropriate read, would be acceptable on the tag?! And again, no mention is made at all about the tag including information pertaining to the manufacture of the bullet.

Applicant further disagrees with the Examiner that "Collier reiterates that it is well known in the art of retail to scan both a good and the good's package in tandem with the identity of a purchaser" (See page 5, lines 10 -11 of the present Office Action). Indeed, Collier teaches that after the package code is entered, the "seller of the bullets then only has to input the name or other forms of identification for the purchaser" and that the "number of code on the tag can be catalogued with the name of the purchaser so that when the identification tag is retrieved from a spent bullet it can be used as a means of identifying the purchaser of the bullet," statements that the Applicant asserts suggest, at best, manual input into a computer system. The Collier *et al.* reference also does not teach, as many of the claims herein, unique codes identifying each item. (See, col. 3, lines 52 – 53 of the Collier *et al.* reference: "All the bullets included in the packaging have the same identification number or code").

Respectfully, the Examiner uses a contorted and erroneous read of the Collier reference in an attempt to fill in perceived holes in U.S. Patent No. 5,34,394 to Roach *et al.*, which in combination with the Collier reference is used to rejection claims 8 - 11 and 21. However, not only is the Collier reference misconstrued and contorted, but so is the disclosure of the Roach *et al.* reference.

First the Applicant asserts that the Examiner has failed to provide adequate motivation for combining the references. The Roach *et al.* reference is related to "an automated system for integrating point of sale and warehouse processing functions in the selection, order and delivery of merchandise" (See col. 1, lines 9 - 14 of U.S. Patent No. 5,434,394), while the Collier *et al.* reference provides a system for bullet registration (See col. 1, line 48 of U.S. Patent No. 5,434,394). The Examiner fails to provide any cogent motivation for combining these two disparate references, other it seems, than the fact that both involve purchase of items.

Second, Applicant disagrees that the Roach *et al.* reference discloses a "customer select[ing] a good to purchase and scan[ning] a bar code ... on the good with scanner" (See, page 4, paragraph 9 of the present Office Action). Instead Roach *et al.* teaches scanning a universal product code label on a good representative of the good to be purchased, with the actual good sold and delivered to the purchaser being sent from a warehouse facility by the delivery option selected by the purchaser (See col. 2, lines 3 - 19 of U.S. Patent No. 5,434,394). There is no indication in the Roach *et al.* reference that the identity of the purchaser is associated with the specific good which is purchased as in independent claims 8 and 21, and therefore claims 9 - 11 which depend from claim 8. Nor, as the Examiner apparently agrees (See page 5, lines 1 - 3 of the present Office Action), does the Roach *et al.* reference teach or suggest that the good is enclosed within a package having an electronically-readable coded form package identifier correlateable with a unique product identifier on/in the good itself, as also required by the rejected claims as amended. The Examiner attempts to fill these holes by the disclosure of Collier. However, the Examiner fails in the recitation of Collier, among other things, to demonstrate on the good an unique product identifier as indicated by both rejected claims 8 and 21, an unique product identifier that identifies the manufacturer of the good, as required by claim 8, and the process of providing the unique product identifier on a medium for further recordation of a subsequent purchaser of the good, as required by claim 10, printing the package identifier and said personal identification information on a sales receipt in electronically readable code form, as required by claim 11, and

transferring the correlated data to a shared database with other retailers, as required in claim 9. The Examiner respectfully appears to ignore all of these recitations by simply stating “teachings” that are said to be in the reference without reciting tangible support for such statements. The Examiner also misconstrues the Collier *et al.* reference as set forth above.

The Roach *et al.* reference is also used by the Examiner in combination with the Collier *et al.* reference to reject claims 12 and 15 - 20 in view of U.S. Patent No. 5,768,384 to Berson *et al.* .

With respect to claim 12, the Examiner admits that neither the Collier *et al.* nor Roach *et al.* reference teaches a good identifier that is invisible to light (See, page 5, paragraph 10 of the Office Action). The Examiner, however, finds such a teaching in the Berson *et al.* reference, which the Examiner characterizes as “teach[ing] an affixed bar code for identifying an article, the bar code invisible to the unaided eye.” *Id.* The Examiner states that “[I]t would have been obvious to one of ordinary skill to employ this well-known tactic, as it prevents an unauthorized person from readily viewing pertinent data regarding an item, which could lead to improper tampering or duplication of that data.” Applicant respectfully traverses once more. The Applicant also notes that the Berson *et al.* reference was filed after the priority application in this case and argues that the reference, therefore, is not prior art with respect to such “teaching.”

Applicant once more asserts the Examiner’s failure to provide adequate motivation for combining the Collier *et al.* reference and the Roach *et al.* reference permeates the rejections of claims 12 and 15 – 20 as well.

As dependent claim 12 depends on claim 8, and claims something less, Applicant asserts that claim 12 is patentable for all of the reasons set forth above with respect to claim 8.

With respect to claim 15, from which dependent claims 16 - 20 depend, Applicant notes that the Examiner further fails to demonstrate, among other things, a unique product identifier in electronically-readable coded form on the good, and a package identifier identifying the type of good, the good's manufacture as well as identifying indicia unique to the good, as required by claim 15, and therefore each dependent claim.

With respect to the rejection of claim 17, the Applicant again points to an Office Action of Examiner Tremblay dated December 2, 1997. At pages 5 – 6 of the December 2, 1997 office action, Examiner Tremblay allows former claims 11 and 19 based on the following statement for the indication of allowable subject matter: “the prior art fails to teach or suggest changing the location of the marking according to lot number. While it is clear that others have attempted to hide the marking, there is no teaching of systematically varying the location according to lot number in the context of the limitations of claims 9 and 17 from which 11 and 19 respectively depend. The person of ordinary skill in the art would not, in the Examiner’s opinion, have any common knowledge of such an arrangement, or motivation to modify the prior art to include this step.” In the rejection of claim 17, the present Examiner appears to directly contradict the prior Examiner and now finds such teaching obvious!

Claims 13 and 14 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over Roach *et al.* as modified by Collier *et al.* in view of U.S. Patent No. 5,823,552. Applicant respectfully traverses such rejection.

First, Applicant argues that claims 13 and 14, that depend from independent claim 8, are patentable for all of the reasons set forth with respect to claim 8 above.

Further, Applicant disagrees that the use of a self-authenticating electronically-readable coded identity card would be obvious in the method of claim 8, independent of the patentability of claim 8 (which Applicant strongly urges). Such identification card not only permits an identity to be correlated to a specific good, but provides a confirmation that the actual person proffering the card, is the person who is authorized to use the card,

and therefore is actual purchaser of the good. Respectfully, none of the references cited by the Examiner, alone or in combination teach or suggest this advantage for such cards.

**CONCLUSIONS**

For all of the above reasons, it is submitted that the present claims are clearly patentable over the art of record.

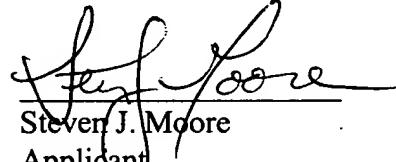
It is submitted that the above-identified patent application is in condition for allowance. Early notification of the allowability of all claims is courteously solicited.

**FEES**

Applicant herein petitions for a one month extension in which to respond to the outstanding Office Action. A one-month extension fee of \$55 is enclosed.

Respectfully submitted,

Dated: June 26, 2002

  
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Steven J. Moore  
Applicant

Appendix A  
Claims Showing Amendments Made in This Response

488. (Once Amended) A computer-assisted method of recording ~~the an~~ identity of a purchaser of a particular good in a retail setting comprising:

accepting from a purchaser at a point of retail sale a good encoded with a unique product ~~a~~ good identifier identifying the manufacturer of a ~~said~~ particular good and containing identification characters indicia ~~unique to the~~ specific to ~~said~~ particular good, said good being enclosed in a package having a visible electronically-readable coded form package identifier correlateable with said good identifier, ~~said package identifier identifying the type of good, the good's manufacturer, as well as identifying the~~ said unique identification characters indicia specific to said particular good ~~on said good~~;

accepting from said purchaser of said good at a point of retail sale an identity card housing electronically-readable personal identification information;

inputting at the point of sale by an electro-optical reader said personal identification information from said identity card into electronic storage ~~at the point of retail sale of said good~~;

inputting at point of retail sale by an electro-optical reader into said electronic storage said visible electronically-readable coded form package identifier and information pertaining to the manufacturer of said particular good ~~at the point of retail sale of said good in tandem with said input of said personal identification information~~;

correlating said personal identification information with said package identifier and information pertaining to the manufacturer of said particular good in a computer database.

499. (Once Amended) The method of claim 488 further comprising the step of transferring said correlated data to a shared database with other retailers.

5010. (Once Amended) The method of claim 488 further comprising the step of: providing ~~said encoded good~~ said unique product identifier to the purchaser in electronically readable coded form on a ~~document~~ medium for further recordation of a subsequent purchaser of said good.

511. (Once Amended) The method of claim 5010 further comprising the step of: printing said package identifier and said personal identification information on a sales receipt in electronically readable coded form at the point of retail sale of said good.

5212. (Once Amended) The method of claim 488 wherein the good identifier is invisible in visible light.

5313. (Once Amended) The method of claim 488 wherein the identity card is a self-authenticating electronically-readable coded identity card.

5414. (Once Amended) The method of claim 488 wherein the identity card is a microcircuit technology card.

5515. (Once Amended) A process for encoding a product with an identifier uniquely correlateable with said product:  
encoding a good with an invisible ~~good~~ unique product identifier in electronically-readable coded form, said ~~good~~ unique product identifier identifying the manufacturer of a particular said good and containing ~~identification elements~~ indicia unique specifically identifying to the particular said good;

on said good or the packaging of said good, placing a package identifier, in visible electronically-readable coded form, which is correlateable with said invisible unique product good identifier, said package identifier identifying the type of good, the good's manufacturer, as well as the identification-elements identifying said -indicia unique to the particular on said good.

5616. (Once Amended) The process of claim 5515 wherein the invisible encoding of the ~~good-unique product~~ identifier is performed below the surface of a material comprising the said good.

5717. (Once Amended) The process of claim 5515 wherein the ~~good-unique product~~ identifier's position on the said good is associated with the lot in which the said good was manufactured.

5818. (Once Amended) The product of the process of claim 5515.

5919. (Once Amended) The method of claim 5515 wherein said visible electronically-readable package identifier which is placed on said good or the packaging of said good further identifies the type of good, the good's manufacturer, and its manufacture or origin of manufacture.

6020. (Once Amended) A computer-assisted method of identifying a record owner of the product, or part thereof, of claim 5818 comprising:

obtaining the good of such product;

determining the ~~unique~~-invisible ~~good-unique product~~ identifier encoded on the said good;

inputting said ~~good-unique product~~ identifier along with the type of good and the good's manufacturer into a data processor operatively connected with a

data base housing purchaser identity information correlated to ~~good~~ unique product identifiers found on a plurality of goods;

retrieving purchaser identity information correlated with said ~~good~~ unique product identifier in said data base;

determining the identity of the purchaser(s) of said good from said purchaser identity information.

6121. (Once Amended) A ~~computerprocessor~~-assisted method of recording the identity of a purchaser of a good, having an unique product identifier thereon containing indicia specifically identifying the particular good, purchased through a data processing telecommunications network comprising:

receiving over a data processing telecommunications network a ~~computer~~digital data signal comprising digital information relating to the order of a good, the identity of the orderer of the good, and the address to which the orderer of the good desires the good to be transmitted, said ~~computer~~digital data signal being transmitted from said ~~orderer's computer to the computer~~ orderer to a ~~of a~~ purveyor of said good;

transmitting from said ~~purveyor's computer~~purveyor, in response to said offerer's order, a ~~computer~~digital data signal comprising a request for said good to a ~~remote computer~~processor located at a site ~~remote from the~~ ~~purveyor's computer~~, ~~said remote computer being~~ located at a site at which such good is physically available as a packaged product comprising said good, and a package surrounding said good, said package having a package identifier in electronically-readable coded form ~~correlateable~~ with the unique ~~good~~ product identifier;

receiving a computer digital data signal from said remote computer form the site at which such good is physically available comprising digital information with respect to the package identifier; and

correlating in a database said package identifier digital information with said digital information pertaining to the identity of the offerer and the address to which the offerer desires the good to be transmitted.

6222. (Once Amended) A computer-assisted purchase and sale method comprising:

accepting from a purchaser at the time of purchase of a good digital identification information identifying the said purchaser, and a contact address of said purchaser, and the good being purchased,

correlating in a relational database said purchaser digital identification information with an identifier associated with the good purchased by said purchaser;

accessing querying a relational database correlating said identifier good with an identifier associated with said good and with one or more associated characteristics of said good;

assessing querying the same or different a relational database which correlates associated characteristics of goods with offers by secondary purveyor(s) proffering good or services directed to such associated characteristics and a contact address of said secondary purveyors;

determining from the identifier associated with said purchased good secondary purveyor(s) of good or services directed to associated characteristics of the purchased good;

proffering the purchaser by way of said purchaser contact address, offers of good or services proffered by said secondary purveyor(s) which are related to associated characteristics of the purchased good;

contacting said secondary purveyor(s) by way of said secondary purveyor(s) contact address to inform said secondary purveyor(s) of the purchaser's response to said ~~proffer~~offer.

- 6323. (Once Amended) The method of claim 6222 wherein the identifier associated with the good being purchased is selected from the group consisting of: a unique product identifier, a unique package identifier, a product information identifier.
- 6424. (Once Amended) The method of claim 6222 wherein the ~~computerprocessor~~-assisted method entails use of ~~the~~a data processing telecommunication network.
- 6525. (Once Amended) The method of claim 6324 wherein the data processing telecommunication network is the Internet.
- 6626. (Once Amended) A method for encoding concealed unique identifiers on products comprising:
  - directing one or more high energy electromagnetic waves at a material in a molten or semi-molten state such that the wave(s) substantially converge at a point within the material;
  - altering the convergence point of said high energy electromagnetic wave(s) such that the three-dimensional structure of the molten or semi-molten material is disrupted such that an unique identifier is formed;
  - using the solidified material in the construct of a product.

6727. (Once Amended) The method of claim 2666 wherein the molten or semi-molten material is a plastic.